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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,145	01/14/2004	Randal J. Jolitz	55616.107495	3169
27526	7590	07/26/2007	EXAMINER	
BLACKWELL SANDERS LLP			CHAPMAN, JEANETTE E	
4801 Main Street				
Suite 1000			ART UNIT	PAPER NUMBER
KANSAS CITY, MO 64112				3635
			MAIL DATE	DELIVERY MODE
			07/26/2007	PAPER

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## **BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**MAILED**

Application Number: 10/757,145

JUL 26 2007

Filing Date: January 14, 2004

Appellant(s): JOLITZ, RANDAL J.

**GROUP 3600**

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William B. Kircher  
For Appellant

## **EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/8/2007 appealing from the Office action  
mailed 11/9/2006.

**(1) *Real Party in Interest***

A statement identifying by name the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) *Status of Claims***

The statement of the status of claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Claimed Subject Matter***

The summary of claimed subject matter contained in the brief is correct.

**(6) *Grounds of Rejection to be Reviewed on Appeal***

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) *Claims Appendix***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) *Evidence Relied Upon***

6,199,338	HUDSON, JR. et al	3-2001
5,953,862	EARHARDT et al	9-1999
4,279,106	GLEASON et al	07-1981
3,852,934	KIRKHUFF	12-1974
2,193,233	HARDY	3-1940
2142996	BUSSEY	1-1939

**(9) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krikhuff (3852934) in view of Gleason et al (4279106). Kirkuff discloses a starter block for facilitating the subsequent positioning of shingles upon a hip roof; the starter block 72 comprising:

1. a top surface 74
2. two side surface
3. a front surface 82 having a rectangular face
4. a back surface 80 having rectangular face
5. the height of the front surface is greater than that of the back surface
6. a shingle 14 placed flat on the top surface 74 will extend back to the roof without bending. See figure 4
7. the width of the starter strip is substantially equal to the width of the shingle, column 8, lines 45-50
8. a nailing zone on the top surface, figure 4
9. the starter block is made of polymer material but does not include a filler commonly used in shingles as shown by Kirkuff, column 6, lines 46-64. It would have been obvious to one of ordinary skill in the art to have the starter block made of not only a foam polyurethane but also like the shingle to create a uniform structure to the roof
10. the front surface is shown in figure 3 to be twice the height of the back; the particular dimensions of the starter block/shingle has been considered a matter of choice; one of ordinary skill in the art would have appreciated the

dimension of the shingle to be used and would have fashioned the starter block accordingly

11. the top surface resembles a slate

12. a coarse of starter blocks

Kirkuff shows the tapered side edges as broadly claimed but lacks the tapered side edges as appellant intended to recite the edges; However, tapered side edges is known in the art of shingles as shown by Gleason et al, element 14, figure 3. It would have been obvious to one of ordinary skill in the art to modify Kirkhuff to taper any edge to give a finished appearance to a starter block as shown by Gleason et al..

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkhuff (3852934) in view of Gleason et al (4279106) as applied to claim 1 above, and further in view of Earhardt (5953862).

The nailing zone is not indented as shown by earhardt et al, see abstract. It would have been obvious to one of ordinary skill in the art to modify Kirkhuff to include the indented nailing zone to accommodate proper placement of the nail upon installation of the starter block and shingles.

Claim 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkhuff (3852934) in view of Gleason et al (4279106) as applied to claim 1 above, and further in view of Bussey(2142996).

Kirkhuff lacks the nibs extending from the side surface of the shingle/starter block.

Bussey discloses nibs 24/25/26 extending from the side surface of his roofing shingle 27. It would have been obvious to one of ordinary skill in tehart to include these nibs on the starter bloc/shingle of Kirkhoff to provide an aligning means upon installation of the starter block/shingles on the roof.

Claim 12-15 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (2193233) in view of Kirkhuff (3852934) in view of Gleason et al (4279106 further in view of Hudson, Jr. et al (6199338).

Hardy discloses a starter block 11 for facilitating the subsequent positioning of shingles upon a hip roof, the starter block 1 comprising:

13. a top surface

14. two side surfaces

15. a front surface having a rectangular face

16. a back surface having rectangular face

17. the height of the front surface is greater than that of the back surface

18. a shingle 12/13/14 placed flat on the top surface will extend back to the roof without bending. See figure 2

19. the width of the starter strip is not disclosed as being equal to the width of the shingle

20. a nailing zone on the top surface, figure 3

21. the starter block is made of polymer material but does not include a filler commonly used in shingles as shown by Kirkuff, column 6, lines 46-64. It

would have been obvious to one of ordinary skill in the art to have the starter block made of not only a foam polyurethane but also like the shingle to create a uniform structure to the roof

22. the front surface is to be twice the height of the back; the particular dimensions of the starter block/shingle has been considered a matter of choice; one of ordinary skill in the art would have appreciated the dimension of the shingle to be used and would have fashioned the starter block accordingly

23. the top surface resembles a slate

24. a coarse of starter blocks

Hardy shows the tapered side edges as broadly recited in the claims but lacks the tapered side edges as applicant argues and as applicant intended to recite these edges. However, the tapered side edges is known in the shingles as shown by Gleason et al, element 14. figure 3. It would have been obvious to one of ordinary skill in the art to modify Hardy to taper any edge to give a finished or different appearance to a starter block as shown by Gleason et al.

Hudson discloses a course of starter shingles of the same length as the shingle. Though Kirkhoff hints at a course of starter blocks, Hudson discloses the course of starter shingles commensurate in dimension with the shingles. It would have been obvious to one having ordinary skill in the art to modify Hardy to include a starter shingle commensurate in dimension with the starter shingle in order to facilitate installation as suggested by Hudson and Kirkhoff.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (2193233) in view of Kirkhuff (3852934) in view of Gleason et al (4279106 further in view of Hudson, Jr. et al (6199338) as applied to claim 12 and further in view of Earhardt. The nailing zone is not indented as shown by Earhardt et al, see abstract. It would have been obvious to one of ordinary skill in the art to modify hardy to include the indented nailing zone to accommodate proper placement of the nail upon installation of the starter block and shingles as shown by Earhardt.

Claim 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy (2193233) in view of Kirkhuff (3852934) in view of Gleason et al (4279106 further in view of Hudson, Jr. et al (6199338) as applied to claim 12 and further in view of Bussey. Hardy lacks the nibs from the side surfaces of the shingle/starter block. Bussey discloses nibs 24/25/26 extending from the side surface of his roofing shingle 27. It would have been obvious to one of ordinary skill in the art to include these nibs on nibs on the starter block/shingle of kirkhoff to provide an aligning means upon installation of the starter block/ shingles on the roof.

#### ***(10) Response to Argument***

Applicant's argues that the above rejection does not provide a *prima facie* case of obviousness and argues there is no motivation to combine through a piecemeal analysis of the references. The scope of the prior art concerns itself with the building industry and mainly roofing shingles. The level of ordinary skill in the art would be someone having a knowledge in the building and roofing industry. The four references cited

in the office action are at least five years old. One of ordinary skill in the art would have appreciated and be familiar with practices and structure in the building /roofing industry that was greater than 5 years old in the art. Most of the references except one deal with the shingle and roofing art. Artisans familiar with shingles and roofing would be familiar with starter shingles since they are not employed exclusive of the shingles. Starter shingles closely resemble, in configuration at least, the configuration of the shingles. Further, the prior art and the claims concern themselves with common building practices and structure such as the wedge shaped starter shingle, the nailing zone, the spacers or nibs. Indeed the limitations such as the nailing zone and the nibs do not limit themselves to the shingle and roofing industry but these limitations are employed through out the building industry. Hence, the examiner has only employed objective evidence of obviousness in combining these references and the differences between the claims and the prior art is minimal at the most.

Applicant argues long felt need with no effective affidavit or declaration linking the claimed subject matter to the need. Further applicant argues the long felt need ".... is directed to the particular problem of providing a starter block that substantially eliminates any gaps between the front portion of the first course of starter shingles and the upper or top surface of the product underlying the first course shingle and/or any gap between the back of the first course shingle and the roof so that the first course shingles may be installed without substantially bending or breaking ." However, applicant does not include the above language in the claims; thus, applicant is arguing more limiting than what is claimed. Further the claims do not recite any structure

distinguishing and linking this need to the recited claim language. Applicant also argues that the base reference of Kirkhuff starter strip "...is ...specifically designed to be used with the Kirkhuff simulated shingles of a special design and configuration." Again the claims do not make this distinction; meaning the starter shingle is not recited to be used with many different types or interchangeable shingles. Applicant also argues that the Kirkhuff patent is therefore nothing more than a part of the background of the unsolved need for applicant's invention. Again applicant does not claim or recite structure linked to the unsolved need/problem. Applicant's claims merely recites the basics for a starter or a shingle. Hence, applicant's claims merely recites nothing more than a part of the background of the unsolved need also. Neither does applicant claim "... a starter block that is usable with different types of shingles so as to prevent the first course of starter shingles from substantially bending. Therefore in view of the above, as much as applicant's claimed invention meets the long felt need with the recited structure so can that of the prior art with the same claimed structural limitations.

Applicant further states that "In determining whether obviousness is established by the teachings of the prior art, "the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art" The combined teachings though one references teaches is not bodily incorporated into the other, that it is obvious to include a starter block with a nailing zone as a means of attachment and a guiding means and it would have been obvious to include the nibs or spacers as a further guide means for positioning the starter blocks. More than adequate motivation has been given above for combining references.

Regarding the tapered edges. Kirkhuff more than adequately discloses one form of the tapered edges since applicant does not clearly and specifically recite his intended though not claimed structure for tapered edges. Applicant argues with the motivation in the rejection above using Gleason. The claims do not limit the reason for adding the tapered edges. Applicant further explains that "the starter block's two side surfaces are tapered so that a shingle placed flat on the top surface will extend back to the roof without substantially bending". However, the starter shingle of Kirkhuff has two side surface that are tapered and when the shingle is placed on the top surface it extends back without bending. Kirkhuff 's side surfaces are tapered from the front surface to the back surface but not in the way applicant intends for the taper to be structured. Applicant explains," the tapered side surfaces of appellants starter block enable the bottom surface of the installed shingle 210 to lie flat on the top surface of the starter block 10". However, the same can be said regarding Kirkhuffs starter block; meaning the, the tapered side surfaces of Kikhuffs starter block enable the bottom surface of the installed shingle 14 to lie flat on the top surface of the starter block 72. Further for the last paragraph of claim 12, Kikhuff discloses at least one course of shingles 14 coupled to the roof, the first course 14 of shingles positioned to lie flat on and at least partially overlap said course of starter blocks 72 with the shingles extending back to said roof without substantially bending.

Appellant also argues the starter block of Kirkhuff is not of a unitary construction. Block 72 in figure 3 is shown to be of a unitary construction.

Appellant also argues that the Gleason reference is not properly combinable with Kirkhuff. Gleason is merely cited to show the tapered side edges to enable a better fit between mating parts while enhancing water drain off. One of ordinary skill in the art would have appreciated that the starter block of Kirkhoff mates with the first shingle and if the edges of the starter block of Kirkhuff were tapered so would the mating edges of the bottom surface of the starter shingle. Applicant's invention and subject matter is no complicated in nature and neither are the obvious changes, well within the scope of Kirkhuff

Applicant argues that the Earhardt reference is not found in applicant's field of endeavor and hence is not properly combinable with Kirkhuff. Nailing zones are not limited to the roofing or shingle industry. They act as guides and a means for securing a structural element to a substrate. This nailing zone is so very common in the building industry that no show of proof should be necessary. However, the reference to Earhardt is shown to illustrate their use on elements configured as that of applicant's. Note: Earhardt reads on the claim limitations of claim 1. Further applicant argues, " Earhardt nailing divot is not for ensuring proper nail placement but rather for weakening the fastening strength of the nail by causing the shim to split in the indented area." The Earhardt reference is not being bodily incorporated into Kirkhuff. It is clear that the nails are to be placed in the area indicated by the nailing zone; this is the base function of all nailing zone as implied by the term; the additional function of each individual nailing zone dependent on each individual building element incorporating the nailing zone. Appellant is arguing intended use.

Regarding the Bussey reference, applicant argues that the prior art does not show nibs or spacers but rather are interlocking fasteners; however, the fasteners of Bussey perform both functions as shown in the drawings. Edges 23 and 24 are spaced as disclosed in page 2, column 2, lines 25-31.

Regarding Hardy, Hardy shows the tapered side edges as claimed; however, as stated similarly above, Gleason shows the taper as applicant intended. The intended taper is to provide a good fit between building parts as well as providing for water drain off. The taper as shown by Gleason would not destroy the teaching of hardy but rather enhance the fit of the building elements which engage each other. The bottom of each shingle shows a taper which would facilitate the step taper of Hardy. The stepped arrangement is also a tapered stepped arrangement. The starter block mates with the bottom of the shingle; One of ordinary skill in the art would have appreciated that the bottom surface of the shingle mates with the top of the starter block even with more of a tapered surface. This fact is not difficult to conceive nor does it require a special genius knowledge to understand how providing more taper on one element would require the same on the other mating element.

Again the applicant does not claim a generic starter block to be used interchangeably with different types of shingles. Contrary to appellant's arguments, hardy does show a unitary piece of material. Neither does the specification state element 11 of several or more than one piece. Other elements are placed on top of the starter block but they are additional materials not the starter block itself.

Regarding Hudson: The entire teaching of Hudson is not incorporated into Hardy but this reference is cited merely to show that starter shingle may have a dimension that is equal to that of the shingle.

In view of the above applicant provides a *prima facie* case of obviousness which includes motivation for combining the references.

**(11) *Related Proceeding(s) Appendix***

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,  
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